<h1 style="text-align: center;">REMARKS/ARGUMENTS</h1>

Claims 1 and 15-28 are pending in the present application. Claims 1 was amended; claims 15-28 were added. Support for these amendments can be found at least at paragraphs [0037]-[0039], [0041]-[0044], [0049]-[0050], [0052]-[0053], and [0055] of the Specification. Reconsideration of the claims is respectfully requested.

I.   **35 U.S.C. § 103, Obviousness**

The Office Action rejects claim 1 under 35 U.S.C. § 103 as being obvious over *Yaker*, U.S. Publication 2002/0090069, in view of *Adkins*, U.S. Publication 2004/0243844. This rejection is respectfully traversed.

In rejecting claim 1, the Examiner states:

> Regarding claim 1, Yaker teaches, **a method for <u>selectively generating automatic notifications that a user is away</u>, the method comprising: <u>responsive to receiving an email message at an email address of the user</u>** (Yaker.pg. 2, par. 25; email tool automatically transmitting the appropriate "out-of-office" message to the third party in response to an incoming email message); **<u>responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender</u>** (Yaker, pg. 2, par. 24-26; Yaker teaches an evaluation process upon receipt of the email as to whether or not an away notification is sent and if so, what information should be sent); **<u>and responsive to a determination that the email address of the sender is not an email address in the list of determined email addresses, not sending an away notification to the email address of the sender</u>** (Yaker.pg. 2, par. 24-26; Yaker teaches an evaluation process upon receipt of the email as to whether or not an away notification is sent and if so, what information should be sent).
>
> While Yaker teaches incoming email messages can be sorted or managed on the basis of a pre-determined criteria, such as source of the email and keywords, i.e. time periods, message fields, etc. that trigger a certain pre-determined response, Yaker does not explicitly teach all limitations regarding **<u>determining whether an e-mail address of the sender of the email message is an email address in a set of determined email addresses comprising</u> email addresses of recipients to which email messages have been previously sent within a configurable time period <u>that</u> is <u>uniquely associated with each email address in the set of determined email addresses, wherein the set of determined email addresses and a date associated with each email address is the set of determined email addresses is stored in a data structure, and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user.</u>**

Adkins teaches **determining whether an e-mail address of the sender of the email message is an email address in a set of determined email addresses comprising** email addresses of recipients to which email messages have been previously sent within a configurable time period **that is uniquely associated with each email address in the set of determined email addresses** (Adkins, fig. 5, steps 501-513; pg. 7, par. 129-135), **wherein the set of determined email addresses and a date associated with each email address is the set of determined email addresses is stored in a data structure** (Adkins, fig. 5, steps 501-513; pg. 7, par. 129-135), **and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user** (Adkins, fig. 5, steps 501-513; pg. 7, par. 129-135).

Adkins and Yaker are analogous art because they are from the same field of endeavor of network communication and messaging. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Adkins method of sorting and determining a specific set of messages with Yaker's method for automatic processing of incoming email messages. The suggestion/motivation would have been to provide an authorized email control system that integrates into an email server architecture as well as a client system (Adkins, pg. 1, par. 11-13).

Final Office Action dated November 5, 2008, pp. 2-4.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are… determined; differences between the prior art and the claims at issue are… ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Amended claim 1 recites:

1.   A method for selectively generating automatic notifications that a user is away, the method comprising:

responsive to receiving an email message at an email address of the user, determining whether an email address of the sender of the email message is an email address in a set of determined email addresses, wherein the set of determined email addresses comprises email addresses of recipients to which email messages have been previously sent within a configurable time period that is uniquely associated with each email address in the set of determined email addresses, wherein the set of determined email addresses and a date associated with each email address in the set of determined email addresses is stored in a data structure, and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user;

responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender;

responsive to a determination that the email address of the sender is not an email address in the list of determined email addresses, not sending an away notification to the email address of the sender;

determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period that is uniquely associated with the email address;

responsive to a determination that the date is within the configurable time period, retaining the email address in the set of determined email addresses; and

responsive to a determination that the date is not within the configurable time period, removing the email address from the set of determined email addresses.

I.A.   *The Proposed Combination Fails to Teach or Suggest All of the Features of Amended Claim 1*

The combination of references, when considered as a whole, fails to teach or suggest all of the features of amended claim 1. For example, *Yaker* in view of *Adkins* fails to teach the following features: 1) responsive to receiving an email message at an email address of the user, determining whether an email address of the sender of the email message is an email address in a set of determined email addresses, wherein the set of determined email addresses comprises email addresses of recipients to which email messages have been previously sent within a configurable time period that is uniquely associated with each email address in the set of determined email addresses; 2) responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender; 3) determining whether the date associated with the email address in

the set of determined email addresses is within the configurable time period that is uniquely associated with the email address; 4) responsive to a determination that the date is within the configurable time period, retaining the email address in the set of determined email addresses; and 5) responsive to a determination that the date is not within the configurable time period, removing the email address from the set of determined email addresses.

I.A.1. Responsive to receiving an email message at an email address of the user, determining whether an email address of the sender of the email message is an email address in a set of determined email addresses

The proposed combination fails to teach or suggest the feature of determining whether an email address is in a set of determined email addresses as in amended claim 1. In rejecting claim 1, the Examiner cites to *Yaker* at paragraph [0025], which states:

> If, however, an entry had been made in the personal scheduler indicating that the user is not available, then the email tool automatically transmits an appropriate "out-of-office" email message to the third party (step 212). The outgoing "out-of-office" message may include information concerning the user's whereabouts (i.e., the categories enumerated above, such as, for example, in a meeting, out of town on business, on vacation, and the like), as well as the duration of time the user will be out of the office or the date upon which the user will be back in the office.

The cited portion of *Yaker* discloses an email tool automatically transmitting an "out-of-office" message to a third party if an entry has been made in the personal scheduler indicating the user is not available. *Yaker* sends automatic out-of-office messages based on whether or not the user is available, as indicated by the user's personal scheduler. However, *Yaker* fails to teach or suggest determining whether an email address of <u>the sender</u> of the email message is in a <u>set of determined email addresses</u>. In fact, *Yaker* never addresses a set of determined email addresses at all. Moreover, *Yaker* fails to even mention any type of determination as to the email address of the <u>sender</u>. Rather, *Yaker* is concerned with the availability of the user only.

The Examiner also cites to *Adkins* at paragraphs [0029]-[0135], which state:

> Referring to FIG. 5, a flowchart of another preferred embodiment of the invention is shown. This embodiment differs from FIG. 4 in that the sender is sent the challenge message more than once. The invention receives an email 501. The invention checks if the email's sender is listed in the user's inclusive address book or temporary address book 502. If the sender is, then the email is acceptable and is placed in the user's main mailbox 503.

If the sender is not in the inclusive or temporary address book, then the invention checks if the sender is listed in the user's exclusive address book 504. If the sender is, then the message is not wanted by the user, i.e., the sender or the sender's domain is blocked, and it is discarded 505.

If the sender is not listed in the exclusive address book, then the invention checks if the sender has been sent a challenge message recently 506. This challenge resend time span can be user settable. If the sender has not been sent a challenge message recently, then a challenge is issued to the sender, requesting that the sender send an acknowledgement with an acceptable (blank) message body 508. The sender is then placed on the domain ID list (if the sender is not already on the list) 509. This indicates that the sender is a repeat offender and is most likely not filter aware. The user is notified that the sender has been added to the domain ID list, giving the user the option to add the sender to his inclusive or exclusive address book (as described above).

If the sender has been sent a challenge request recently, then the invention checks if the sender has sent a proper acknowledgement to the challenge message within a user settable time interval 507. If the sender has not, then the sender is then placed on the domain ID list (if the sender is not already on the list) 509. The user is notified that the sender has been added to the domain ID list, giving the user the option to add the sender to his inclusive or exclusive address book (as described above).

Otherwise, a list of all the messages from the sender in the pending queue is created 510. Each of the messages in the list have the message bodies truncated to a user settable length (as noted above) and checked if any of the truncated messages contain contact information 511. If any of the messages do not contain contact information, then the sender is added to the sender ID list 513. The sender ID list can reference all messages from such a sender, or just the acceptable ones. Only the acceptable ones are accessible from the sender ID list by default. The user is notified that the sender has been added to the sender ID list, giving the user the option to add the sender to his inclusive or exclusive address book (as described above).

If any of the messages do contain contact information, then the sender is warned that its email was rejected and the reason(s) why 512.

The user is also notified each time a message is pended on the domain ID list or sender ID list or only when a unique entry is added to the list.

The cited portion of *Adkins* discloses an invention that checks if the email's sender is listed in the user's inclusive address book or temporary address book, and accepts the message if the sender is in one of those books. The invention in *Adkins* is concerned with whether or not to accept an email message into a user's mailbox. If the email's sender in *Adkins* is in an exclusive

address book, the invention determines the sender is blocked and <u>discards the email message from the sender</u>. If the sender in *Adkins* is not found in any address book, a challenge message is sent to the sender, and the user is either informed that the sender is not part of the address books, or that the sender has been added to a particular address book. Regardless, the invention of *Adkins* is concerned with allowing or disallowing a sender's message to reach a user's mailbox. The determination in *Adkins* is to the correct address book category for a sender's email. The address books in *Adkins* are either inclusive – allow message to reach inbox, exclusive – discard message without allowing it to reach inbox, or temporary – awaiting response to challenge message to determine if sender belongs in inclusive or exclusive category.

However, *Adkins* fails to teach or suggest determining whether an email address of the sender of the email message is an email address in a set of determined email addresses, wherein the set of determined email addresses comprises email addresses of <u>recipients to which email messages have been previously sent within a configurable time period</u>. *Adkins* fails to address email addresses associated with a configurable time period in a set of determined email addresses. Thus, the proposed combination fails to teach or suggest the feature of "responsive to receiving an email message at an email address of the user, determining whether an email address of the sender of the email message is an email address in a set of determined email addresses, wherein the set of determined email addresses comprises email addresses of recipients to which email messages have been previously sent within a configurable time period that is uniquely associated with each email address in the set of determined email addresses," as in amended claim 1.

I.A.2. Responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender

The proposed combination fails to teach or suggest the feature of sending an away notification as in amended claim 1. In rejecting claim 1, the Examiner cites to *Yaker* at paragraph [0024], which states:

When the email tool receives an incoming email message from a third party (step 204), the email tool accesses the personal scheduler (step 206) via interface 106. An evaluation is then made to determine whether the user is available to receive the message at that time (step 208). If the user does not have a suitable entry in the personal scheduler and is therefore presumably available to receive and respond to incoming email messages, processing ends (step 210).

The cited portion of *Yaker* discloses that, responsive to receiving an incoming email message, the tool determines whether the user is available. However, *Yaker* fails to teach or suggest determining whether the email address of the sender is in the set of determining email addresses.

The Examiner also cites to *Yaker* at paragraph [0025], reproduced above. As discussed above, *Yaker* sends automatic out-of-office messages based on whether or not the user is available, as indicated by the user's personal scheduler. However, *Yaker* fails to teach or suggest determining whether an email address of the sender of the email message is in a set of determined email addresses. Further, *Yaker* fails to disclose sending an away notification in response to a determination that the email address of the sender is in the set of determined email addresses. In fact, *Yaker* never addresses a set of determined email addresses at all.

The Examiner further cites to *Yaker* at paragraph [0026], which states:

> In addition, the user may prepare a series of messages providing different information wherein the email tool is programmed to disseminate a particular message depending on particular circumstances. For example, different messages may be sent depending on the type of activity entered into the personal scheduler, where the different messages provide the third party with different information depending on the type of activity. Alternatively or in addition, the email tool may interpret the incoming email message based on pre-determined criteria, such as but not limited to, the source of the email message (i.e., whether it be within the network or outside the user's network) or key words found within the email message that serve to trigger a certain prepared response. Finally, the incoming message from the third party and the outgoing message from the user are logged in the in box and out box, respectively, of the email system of the user.

Here, *Yaker* teaches configurable messages sent based on the type of activity entered into the user's personal scheduler. *Yaker* also discloses interpreting the incoming message based on pre-determined criteria, such as the source of the email message – whether it is within the user's network or from outside the user's network, or key words within the email that trigger a prepared response. However, *Yaker* fails to teach a determination that the email address of the sender is in

a <u>set of determined email addresses</u>. Further, *Yaker* fails to teach or suggest that an away message is sent in response to a determination that the email address of the sender is in the set of determined email addresses. Rather, *Yaker* is concerned with the user's availability, and automatically sends an out-of-office message to every message received. The only determination made as to the away notification sent in *Yaker* is to the content of the message – a different message based on a key word trigger or the user's personal schedule – not a determination as to whether an automatic notification should be sent. Thus, the proposed combination fails to teach or suggest the feature of "responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender," as in amended claim 1.

I.A.3. Determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period that is uniquely associated with the email address

The proposed combination fails to teach or suggest the feature of determining whether the date associated with the email address is within a configurable time period as in amended claim 1. As discussed above, neither *Yaker* nor *Adkins* addresses a determined set of email addresses that comprise email addresses of recipients to which email messages have been previously sent within a configurable time period. Where neither reference teaches a set of determined email addresses and a configurable time period, the proposed combination cannot further disclose the feature of determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period uniquely associated with the email address. In fact, neither reference even mentions a configurable time period uniquely associated with an email address at all. Thus, the proposed combination fails to teach or suggest the feature of "determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period that is uniquely associated with the email address," as in amended claim 1.

I.A.4. Responsive to a determination that the date is within the configurable time period, retaining the email address in the set of determined email addresses

The proposed combination fails to teach or suggest the feature of retaining the email address in the set of determined email addresses as in amended claim 1. As discussed above, neither *Yaker* nor *Adkins* addresses a determined set of email addresses that comprise email addresses of recipients to which email messages have been previously sent within a configurable time period. Where neither reference teaches a set of determined email addresses and a configurable time period, or determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period uniquely associated with the email address, the proposed combination cannot further teach retaining the email address in response to a determination that the date is within the configurable time period.

Moreover, neither reference even mentions retaining an email address that is within a configurable time period, or a configurable time period uniquely associated with an email address, at all. Thus, the proposed combination fails to teach or suggest the feature of "responsive to a determination that the date is within the configurable time period, retaining the email address in the set of determined email addresses," as in amended claim 1.

I.A.5. Responsive to a determination that the date is not within the configurable time period, removing the email address from the set of determined email addresses

The proposed combination fails to teach or suggest the feature of removing the email address in the set of determined email addresses as in amended claim 1. As discussed above, neither *Yaker* nor *Adkins* addresses a determined set of email addresses that comprise email addresses of recipients to which email messages have been previously sent within a configurable time period. Where neither reference teaches a set of determined email addresses and a configurable time period, or determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period uniquely associated with the email address, the proposed combination cannot further teach removing the email address in response to a determination that the date is not within the configurable time period.

Moreover, neither reference even mentions removing an email address that is not within a configurable time period, or a configurable time period uniquely associated with an email address, at all. Thus, the proposed combination fails to teach or suggest the feature of

"responsive to a determination that the date is not within the configurable time period, removing the email address from the set of determined email addresses," as in amended claim 1.

Therefore, it is respectfully urged that the rejection of claim 1 under 35 U.S.C. § 103 has been overcome.

I.B. *There is No Sufficient Reason to Modify the Reference*

In the case at hand, the Examiner cannot establish a *prima facie* obviousness rejection against amended claim 1 because no sufficient reason to modify *Yaker* in view of *Adkins* exists in light of the differences between the cited art and amended claim 1. Specifically as shown above, *Yaker* in view of *Adkins* fails to teach or suggest the features of: 1) responsive to receiving an email message at an email address of the user, determining whether an email address of the sender of the email message is an email address in a set of determined email addresses, wherein the set of determined email addresses comprises email addresses of recipients to which email messages have been previously sent within a configurable time period that is uniquely associated with each email address in the set of determined email addresses; 2) responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender; 3) determining whether the date associated with the email address in the set of determined email addresses is within the configurable time period that is uniquely associated with the email address; 4) responsive to a determination that the date is within the configurable time period, retaining the email address in the set of determined email addresses; and 5) responsive to a determination that the date is not within the configurable time period, removing the email address from the set of determined email addresses.

The Examiner's proposed reason for modifying the cited art in view of the previously presented claims provides no rational underpinning to support a legal conclusion of obviousness. Regarding a reason to modify *Yaker*, the Examiner states that:

> Adkins and Yaker are analogous art because they are from the same field of endeavor of network communication and messaging. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Adkins method of sorting and determining a specific set of messages with Yaker's method for automatic processing of incoming email messages. The suggestion/motivation would have been to provide an authorized email control

system that integrates into an email server architecture as well as a client system (Adkins, pg. 1, par. 11-13).

The Examiner offers an advantage as the stated reason for modifying the teachings of *Yaker* in view of *Adkins* in the manner proposed by the Examiner. Specifically, the Examiner proposed modifying the cited art because it would provide an authorized email control system that integrates into an email server architecture as well as a client system. However, the Examiner fails to provide a sufficient reason to modify *Yaker* in view of *Adkins* because the Examiner merely offers a possible advantage for the modification without providing any reason for the modification. In particular, the Examiner cannot provide any reason for modifying *Yaker* in view of *Adkins* to provide an authorized email control system that integrates into an email server architecture as well as a client system where neither *Yaker* nor *Adkins* teach or suggest all of the features of amended claim 1.

Moreover, one of ordinary skill in the art would not be motivated to combine the references, when considered as a whole, in the manner proposed by the Examiner. Assuming, *arguendo*, that combining the references was considered, one of ordinary skill in the art would look at the problems addressed when considering the references as a whole. Although both *Yaker* and *Adkins* address email systems, each reference is directed towards a different problem and different solutions. One of ordinary skill in the art would not be motivated to combine a system for filtering junk mail with a system for automating activation and deactivation of an out-of-office message.

Adkins is concerned with filtering junk mail. *See Adkins* at ¶ [0006]-[0008]. The problem in *Adkins* is addressed by automatically deleting messages from an email address or domain name that the user has identified as junk mail without allowing the message to reach the user's inbox. *See Adkins* at ¶ [0012]-[0017]. If the email address has been previously identified by the user as allowable, the message is put in the user's main mailbox. *Id.* If the user in *Adkins* has not specifically included an email address in an inclusive address book of allowed addresses, the system analyzes the message through filters with a pass/fail indicator. If the message passes the filters, the email address is added to the allowed addresses list and placed in the user's mailbox. *Id. Adkins* is directed towards a junk mail filtering system that allows or disallows messages to reach a user's mailbox. *Adkins* is not concerned with generating out-of-office

messages in response to incoming email messages. In fact, many incoming messages never even reach the user's mailbox.

Addressing a different problem altogether, *Yaker* is concerned with having to manually activate and deactivate an out-of-office message in reply to incoming email messages. *See Yaker* at ¶ [0005]-[0006]. The problem in *Yaker* is addressed by allowing an email system to access a user's personal scheduler and automatically activate or deactivate the out-of-office message function based on the user's schedule. *See Yaker* at ¶ [0008]-[0009]. *Yaker* is directed toward a solution that eliminates the need for a user to have to manually activate or deactivate out-of-office messaging functions. However, *Yaker* is not concerned with filtering incoming messages, or disallowing certain messages to reach the user's mailbox. In fact, all messages are received in *Yaker* and all messages are sent an out-of-office message in reply. The only selective process in *Yaker* is to the <u>content</u> of the out-of-office message that is sent. *See Yaker* at ¶ [0026].

Because of the differences in the cited art, one of ordinary skill in the art would not be motivated to combine the references. Even if one did combine the references, the resulting combination would not reach the presently claimed invention. Assuming, *arguendo*, that the references were combined, the resulting combination would be directed to a system for automatically activating or deactivating an out-of-office message for messages received in a user's mailbox after unwanted messages have been filtered out as junk mail. However, the resulting combination fails to reach the presently claimed invention of determining whether an email address of the sender of the email message is an email address in a set of determined email addresses, where the set of determined email addresses comprise email addresses of <u>recipients to which email messages have been previously sent within a configurable time period</u> that is uniquely associated with each email address in the set of determined email addresses. The resulting combination further fails to reach the presently claimed feature of selectively sending an away notification based on whether or not the email address of the sender is in the set of determined email addresses.

Thus, the Examiner's reason for modifying *Yaker* in view of *Adkins* provides an insufficient basis for modifying the teachings of the cited art in the manner necessary to reach each and every feature of amended claim 1, especially in light of the differences that exist between *Yaker* in view of *Adkins* and amended claim 1.

For these reasons, the rejection of obviousness vis-à-vis amended claim 1 has been overcome.

I.C. *Independent Claims*

Newly added independent claims 19 and 24 recite similar subject matter as that of amended claim 1. As shown above, amended claim 1 is not obvious over the cited art and is therefore in condition for allowance. Thus, at least for the reasons set forth above in regard to claim 1, independent claims 19 and 24 are also non-obvious over the cited art.

I.D. *Dependent Claims*

If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefore is also non-obvious by virtue of their dependency. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 15-18, 20-23, and 25-28 depend from claims 1, 19, and 24. Applicants have already demonstrated claims 1, 19, and 24 are not obvious and are therefore in condition for allowance. Therefore, at least by virtue of their dependence on claims 1, 19, and 24, claims 15-18, 20-23, and 25-28 are not obvious over *Yaker* in view of *Adkins*.

In addition, the dependent claims recite additional combinations of features not taught by the cited art. For example, dependent claim 15 recites "responsive to sending an outgoing email message at the email address of the user, identifying a first recipient email address; and determining whether the first recipient email address is located in the set of determined email addresses." As discussed above, neither *Yaker* nor *Adkins* discloses a set of determined email addresses as in the presently claimed invention. Furthermore, the references, when considered as a whole, fail to teach of suggest identifying a first recipient email address in an <u>outgoing</u> email message. In fact, neither reference is concerned with identifying the recipient email address in an outgoing message at all. As discussed above, *Yaker* is concerned with sending an out-of-office message based on the user's schedule, while *Adkins* is concerned with filtering junk mail. Moreover, neither reference even considers determining whether the recipient email address in an <u>outgoing</u> message is located in a set of determined email addresses. Thus, the proposed combination fails to teach or suggest the feature of "responsive to sending an outgoing email message at the email address of the user, identifying a first recipient email address; and

determining whether the first recipient email address is located in the set of determined email addresses," as in claim 15.

Additionally, dependent claim 18 recites "responsive to a determination that the first recipient email address is located in the set of determined email addresses, updating the date associated with the first recipient email address in the set of determined email addresses." As previously discussed, neither *Yaker* nor *Adkins* teach or suggest the features of a set of determined email addresses. Neither do the references teach or suggest the feature of identifying a recipient email address in an outgoing message and determining if that recipient email address is in the set of determined email addresses. As such, the proposed combination cannot further teach updating the date associated with the email address in the set of determined email addresses in response to determining the email address is located in the set. Moreover, neither reference ever addresses a date uniquely associated with each email address in the set of determined email addresses, as in amended claim 1 from which claim 18 depends, much less updating that date based on an <u>outgoing message</u> sent from the user to the recipient email address. Therefore, neither *Yaker* nor *Adkins* teach or suggest all the features of dependent claim 18.

As shown above, *Yaker* in view of *Adkins* fails to teach or suggest all of the features of claims 1, and 15-28. Additionally, no motivation to combine the references exists. Therefore, the proposed combination and modification of the cited references when considered together as a whole does not teach or suggest all of the features of claims 1 and 15-28. Therefore, it is respectfully urged that claims 1 and 15-28 are now in condition for allowance.

II.   <u>Conclusion</u>

The subject application is patentable over the cited references of *Yaker* and *Adkins* and is now in condition for allowance, a notice of which is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite prosecution or aid the examination of this application.

DATE: <u>January 30, 2009</u>

Respectfully submitted,

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